

REMARKS

Claims 35, 36, 38-64, 66 and 68 are pending in the application. Claims 35, 48, 54 and 59-63 are currently amended. Claims 1-34, 37, 65, and 67 are cancelled.

I. Claim Amendments

Claims 48 and 54 have been amended responsive to the Examiner's remarks, as discussed more fully in Sections II and IV below.

Claims 35 and 59-63 have been amended to remove the limitation "wherein the composition comprises a mixture of long-chain alkyl polyamine compounds having a range of different alkyl chain lengths" to more fully claim the subject matter of the present invention as disclosed in the specification. No new matter has been added.

II. Claim Objections

Claim 55 (first instance) stands objected to because of the following informalities: the claim should be numbered as claim 54. Applicant herein amends Claim 55 (first instance) to Claim 54 and respectfully requests that the objection be withdrawn.

III. Non-Statutory Double Patenting Type Rejections

Claims 35, 36, 38-54 and 59-62 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 45 of co-pending U.S. Patent Application No. 11/054,474.

Applicant notes that Claim 45 of co-pending U.S. Patent Application No. 11/054,474 is currently cancelled, hence the rejection is moot.

Claims 35, 36, 38-64, 66 and 68 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-40 of co-pending Application No. 11/569,287.

With regard to these double patenting rejections, Applicant respectfully submits that the filing of terminal disclaimers will be considered on notification that the pending claims are otherwise allowable.

IV. Claim Rejections Under 35 U.S.C. 112, Second Paragraph

Claim 48 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner argues “w-propanol” should be “i-propanol” or “n-propanol.”

Applicant herein amends Claim 48 such that “w-propanol” is now “n-propanol.” and respectfully requests that the rejection of Claim 48 under 35 U.S.C. 112, second paragraph be withdrawn.

V. Claim Rejections Under 35 U.S.C. 103(a)

Claims 35, 36, 38-64, 66 and 68 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,276,047 to Eggensperger et al. (“Eggensperger”) in view of U.S. Patent No. 6,387,856 to Ofusu-Asante et al. (“Ofusu-Asante”). Applicant respectfully traverses.

A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. KSR Int’l Co. v. Teleflex, 127 S.Ct 1727, 1741 (2007). As former Chief Judge Markey of the Federal Circuit has stated, “virtually all inventions are ‘combinations’, and ... every invention is formed of ‘old elements’ Only God works from nothing. Man must work with old elements.” H.T. Markey, *Why Not the Statute?* 65 J. Pat. Off. Soc’y 331, 333-334 (1983). The factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. KSR Int’l Co. v. Teleflex, 127 S.Ct at 1742. In determining whether a claimed invention is an obvious combination of prior art references, it must be shown there is an apparent reason to combine the known elements in the fashion claimed. Id. at 1741. To facilitate review, this analysis should be made explicit. Id.

The suggested combination of Eggensperger and Ofusu-Asante would only be made by hindsight. There are significant technical reasons why the skilled person would not make such a combination. There are potentially thousands of different disinfecting compositions available at the priority date. The Examiner has, with hindsight, selected one such composition, without any reason why this one composition would be selected.

Ofusu-Asante clearly states in paragraph 2 that iodine can undermine the stability of certain liquid dishwashing compositions. See lines 7 to 15 of column 2. A person of ordinary skill in the art would not choose to use iodine alone in admixture with the composition of Eggensperger. Applicant acknowledges that a solution to the unacceptable properties of iodine is described in lines 42 to 58 on column 2 of Ofusu-Asante. Specifically, iodine is used in conjunction with an amphoteric surfactant. The amphoteric surfactant is then used to ameliorate the deleterious consequences of iodine.

Were the teaching of Ofusu-Asante to be combined with Eggensperger, which Applicant disputes, then a person of ordinary skill in the art would necessarily need to not only use iodine, but iodine in combination with an amphoteric surfactant to form an iodophor complex. Were such a combination to be made, the final composition would comprise, at least, BIT, the amine of formula 1 of Eggensperger, iodine in the form of an iodophor with an amphoteric surfactant. This is not an obvious step.

First, in order to form the iodophor complex, the iodine must be mixed with the amphoteric surfactant prior to mixture with the composition of Eggensperger. This need to pre-mix would deter a person of ordinary skill in the art from selecting such an additional disinfecting component. There are significant numbers of other disinfecting components that might be chosen without the need for pre-mixing, and thus increasing the complexity of the production process. A person of ordinary skill in the art would not look to complicate the production process.

Secondly, Eggensperger discloses that additives may be included in the formulation, such as nonionic, cationic and/or anionic surfactant but it does not mention the use of amphoteric surfactants. This is yet another reason why a person of ordinary skill in the art would not look to combine these disclosure and another reason why the suggested combination would only be made by hindsight.

Thirdly, Eggensperger discloses that the total amount of conventional additives such as non-ionic, cationic or anionic surfactants is up to 25%. Preferably it is 10% - 20%. In stark contrast, the composition of Ofusu-Asante is said to preferably comprise from about 25% to about 70% by weight surfactant. (Column 3 lines 65 to 67). Thus the surfactant composition of

Eggensperger and the surfactant composition of Ofusu-Asante are non-overlapping in the preferred embodiments with respect to the concentration of surfactants. A person of ordinary skill in the art would not, then, look to incorporate an iodophor into the very different chemical background of the composition of Eggensperger. A person of ordinary skill in the art would actively have to decide to go against the preferred surfactant background of Ofusu-Asante.

In summary, there are technical reasons why the skilled person would not combine the two disclosures; namely:

- The deleterious effects of iodine taught in the disclosure of Ofusu-Asante.
- The fact that iodine would have to be in combination with an amphoteric surfactant as an iodophor complex, increasing the complexity of the detergent manufacture;
- The fact that amphoteric surfactants are not taught in Eggensperger as possible additives; and
- The fact that the composition of Eggensperger allows for additives, such as surfactants only in an amount up to 25%, whereas the disclosure of Ofusu-Asante has a preferred range of surfactants preferably from 25% to 70%.

Therefore, for at least the reasons above, the present invention as claimed in Claims 35, 36, 38-64, 66 and 68, as amended, is not an obvious combination of Eggensperger and Ofusu-Asante. The Examiner has failed to show that there is an apparent reason to combine the elements of Eggensperger and Ofusu-Asante in the fashion claimed. If anything, the cited references teach away from such a combination.

The Applicant respectfully requests that the rejections of Claims 35, 36, 38-64, 66 and 68 under 35 U.S.C. 103(a) be withdrawn.

VI. Conclusion

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that claims 35, 36, 38-64, 66 and 68 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, the Examiner is courteously requested to contact applicant's undersigned representative.

The Commissioner is authorized to charge any additional fees associated with this filing, or credit any overpayment, to Deposit Account No. 50-2638. If an extension of time is required, this should be considered a petition therefor.

Respectfully submitted,

/Richard E. Kurtz/Reg. #33,936

Richard E. Kurtz
Reg. No. 33,936
Attorney for Applicant

GREENBERG TRAURIG
Greenberg Traurig, LLP
2101 L Street, N.W.
Suite 1000
Washington, D.C. 20037
202-331-3100

E-mail: kurtzr@gtlaw.com

Filed: October 6, 2008